

**REMARKS**

Applicants have studied the Office Action dated November 15, 2004 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-7 and 9-21 are pending. Claims 1-3, 5, 7 and 11-12 have been amended. Claims 13-21 have been added. Claim 8 has been cancelled without prejudice. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1-3) rejected claims 1 and 4-11 under 35 U.S.C. § 102(b) as being anticipated by Moran (U.S. Patent No. 3,020,643);
- (4-5) rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Moran (U.S. Patent No. 3,020,643) in view of Klein (U.S. Patent No. 1,011,628); and
- (7-8) rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Moran (U.S. Patent No. 3,020,643) in view of Ciolli et al. (U.S. Patent Pub. No. US 6,546,119 B2)

**(1-3) Rejection under 35 U.S.C. §102(b) by Moran**

As noted above, the Examiner rejected claims 1 and 4-11 under 35 U.S.C. § 102(b) as being anticipated by Moran (U.S. Patent No. 3,020,643). Independent claims 1 and 11 have been amended to distinguish and to more clearly define the present invention.

Before discussing the cited reference in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 1 recites, *inter alia*:

a base including a first section that is oriented in a mostly horizontal plane, a downward-facing surface of the base being the zero mark for measuring the fish;

a foldable measuring tape having distance indicators along the length of the tape, a first end of the tape being attached to the base; and

an opening that penetrates completely through the first section of the base such that the fish holder can be inserted into the opening while the fish is attached to the fish holder, so that gravity causes the foldable measuring tape and the fish to hang in the same downward direction. (emphasis added)

Amended claim 11 recites, *inter alia*:

holding a fish at a first end with a holding device;

inserting the fish and holding device into **an opening in a horizontally-oriented section of a measuring device** so that the first end of the fish is aligned with a downward-facing surface of the measuring device;

providing a flexible measuring tape that is attached to the measuring device so that **gravity causes the measuring tape and the fish to hang in the same downward direction** with the fish being positioned between the tape and an observer; and

visually determining the length of the fish by comparing a distal second end of the fish to distance indicators provided on the tape. (emphasis added)

The present invention, as is shown in FIG. 4 of the instant application, is a fish measuring device that conveniently slides over a fish-holding device and rests on an end of a fish (which is the zero mark for measuring) being held by the fish-holding device. A high-contrast measuring tape is weighted and hangs from the base. A measurement from the end of the fish touching the "downward facing surface of the base" to a distal end of the fish can be obtained by simply taking a picture with the fish being positioned between the tape and the photographer.

The device includes a base section that is provided with an opening 11 in a first section 9 of the base. See FIG. 4 of the instant application. The opening accommodates the fish 3 and fish-holding device 2. *Id.* A measuring tape is attached to the base. The

tape is calibrated so that the downward facing surface of the base is the zero mark for a measurement and gravity pulls the measuring tape straight and towards the ground. If the first section of the base is oriented parallel to the ground, i.e., so that a line perpendicular to the ground passes up and through the opening in the base, the fish and tape will be hung parallel with each other. See FIG. 4.

The Moran reference, in contrast, discloses an apparatus for measuring the length of a baby. The Moran apparatus is an elongated housing containing a retractable flexible sheet secured to a roller. Moran, col. 1, lines 50-52 and col. 2, lines 6-7. The sheet is secured to a solid foot plate, which when pulled by utilizing a ring-type handle, extends the sheet. Moran, col. 2, lines 23-31. A baby or other object can then be placed on the sheet and a measurement can be made thereof. Moran, col. 2, lines 44-48.

Because the apparatus of Moran is intended to measure single objects that do not need to be held, the apparatus of Moran cannot, and has no motivation to, slide over and rest on a fish-holding device, as does the present invention. On page 2 of the above-referenced Office action, the Examiner parallels the base section of the present invention to the solid foot plate in Moran. Moran, however, is not concerned with accommodating a holder for the subject being measured on the sheet, i.e. a baby. The subject in Moran is laid on the sheet by itself (See FIG. 2 of Moran) or, alternatively, stand on the ground in front of the apparatus in Moran (See FIG. 5 of Moran). In short, there is no reason for Moran to accommodate a holding device.

Moran does not teach **"an opening** that penetrates completely through a portion of the base" as stated in amended claim 1 of the present invention. Similarly, Moran does not teach "inserting the fish and holding device into **an opening** in a horizontally-oriented measuring device so that a first end of the fish is aligned with a downward-facing surface of the measuring device", as does amended claim 11 of the instant application.

Continuing further, the foot plate of Moran is not provided any opening, so it is impossible for Moran to teach an opening that allows a "fish holder [to] be inserted into the opening while the fish is attached to the fish holder, so that gravity causes the foldable measuring tape and the fish to hang in the same downward direction" as is stated in independent claim 1 of the instant application. Similarly, Moran cannot possibly teach "inserting the fish and holding device into an opening in a horizontally-oriented measuring device so that ... gravity causes the measuring tape and the fish to hang in the same downward direction."

Moran does not include any opening in the base that, in any orientation, accommodates a fish-holding device and a fish, as claimed in the present invention. The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.<sup>1</sup> By virtue of this amendment, independent claim 11 has been amended to contain similar limitations to independent claim 1. Because at least one element in independent claims 1 and 11 (at least "an opening that penetrates completely through a portion of the base" and "inserting the fish and holding device into an opening in a horizontally-oriented measuring device") is not taught by Moran, the apparatus of Moran does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1 or claim 11. Accordingly, the present invention distinguishes over Moran for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(4-6) Rejection under 35 U.S.C. §103(a) by Moran in view of Klein

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<sup>1</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

As noted above, the Examiner rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Moran (U.S. Patent No. 3,020,643) in view of Klein (U.S. Patent No. 1,011,628).<sup>2</sup> Independent claim 1, of which claims 2 and 3 depend, has been amended to distinguish and to more clearly define the present invention. Support for the changes is found in FIG. 4 and generally throughout the entire specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 1 recites, *inter alia*:

a base including a first section that is oriented in a mostly horizontal plane, **a downward-facing surface of the base being the zero mark for measuring the fish;**

a foldable measuring tape having distance indicators along the length of the tape, a first end of the tape being attached to the base; and

an opening that penetrates completely through the first section of the base such that **the fish holder can be inserted into the opening while the fish is attached to the fish holder, so that gravity causes the foldable measuring tape and the fish to hang in the same downward direction.** (emphasis added)

As stated above, Moran, as recognized by the Examiner on page 3 of the above-referenced Office action, does not teach "a base section **having a groove** that penetrates through the base and extends from an edge of the base to an area near a center of the base," as was recited in original claim 1. It is submitted that Moran similarly does not disclose "an opening that penetrates completely through a portion of the base such that the fish holder can be inserted into the opening," as is recited in newly amended claim 1.

Additionally, on page 2 of the above-referenced Office action, the Examiner analogizes the foot plate 23 of Moran with the base of the present invention. However, FIG. 5 of

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<sup>2</sup> Applicant makes no statement as to whether such a combination is even proper.

Moran shows that when the apparatus of Moran is used in a non-horizontal orientation, the elongated box 11 is **above** the foot plate 23. Therefore, contrary to the present invention, the measuring tape of Moran is only used **above** the base. It is therefore impossible for Moran to disclose—and *Moran actually teaches away from*—"an opening that penetrates completely through a portion of the base such that the fish holder can be inserted into the opening while the fish is attached to the fish holder, **so that gravity causes the foldable measuring tape and the fish to hang in the same downward direction**" as recited in claim 1 of the instant application.

In any orientation, Moran cannot accommodate, a fish-holding device and a fish, as claimed in the present invention. For a fish to be properly measured by the device taught in Moran, the fish would have to be separated from the holding device, which would defeat the purpose of the present invention, which is to quickly and accurately obtain and record the length of a caught fish, so the fish can quickly be released.

The Klein reference shows a simple tape measure pivotally attached to a plate with a tongue. As can be seen in FIG. 2 of Klein, the measuring tape B has a binding C at its beginning end (the zero mark) and is connected by a pivot D to the tongue A<sup>4</sup> of the plate A. Klein, lines 49-54. The binding C provides a rigid material to place the pivot. Importantly, the rigid binding of Klein ensures that the zero mark on the tape is always aligned with one of two edges A<sup>5</sup> or A<sup>6</sup> on the plate **and always parallel to the plate**.

For an accurate measurement with the apparatus of Klein, the plate and tape must be parallel and the tape must be aligned with either edge A<sup>5</sup> or A<sup>6</sup> **and not "a downward facing surface of the base"** as recited in claim 1 of the instant application. In other words, for the Klein device to properly function, the beginning point of the object being measured must be **parallel** with the plate A and not perpendicular, as would be required to obtain an accurate measurement "if the downward facing surface is the zero mark for measuring." See Klein, FIG 1 and claim 1 of the instant application.

Therefore, the Klein reference does not show the elements of claim 1 of the instant application, namely **"a base oriented in a mostly horizontal plane and a downward facing surface of the base being the zero mark for measuring the fish...an opening that penetrates completely through a portion of the base such that the fish holder can be inserted into the opening while the fish is attached to the fish holder, so that gravity causes the foldable measuring tape and the fish to hang in the same downward direction."**

In fact, the Klein reference is inoperable and cannot produce an accurate measurement if the tape and the plate are perpendicular to each other because the binding attaching the tape to the plate will cause part of the tape to remain parallel to the plate. The zero mark of the tape will be arbitrary, will **not be a downward facing surface** of the plate, and accurate measurement will be impossible due to the bend in the measuring tape. Klein, like Moran, teaches away from the present invention. References that produce seemingly inoperative devices cannot serve as predicates for a prima facie case of obviousness.<sup>3</sup>

The Examiner recites 35 U.S.C. § 103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter as a whole and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention as a whole. Moran taken alone and/or in view of Klein simply does not teach or suggest "a base oriented in a mostly horizontal plane and a downward facing surface of the base being the zero mark" and "an opening that penetrates completely through a portion of the base such

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<sup>3</sup> Michael L. McGinely versus Franklin Sports, Inc. (Fed Cir 2001) ("If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness."); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

that the fish holder can be inserted into the opening while the fish is attached to the fish holder, so that gravity causes the foldable measuring tape and the fish to hang in the same downward direction."

Continuing further, when there is no suggestion or teaching in the prior art for that disclosed in the application, the suggestion can not come from the Applicants' own specification. As the Federal Circuit has repeatedly warned against using the Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is accordingly believed to be clear that Moran whether taken alone or in combination with Klein, neither shows nor suggests the features of claim 1. Claims 2 and 3 depend from claim 1. Since dependent claims contain all the limitations of the independent claims, claims 2 and 3 distinguish over Moran and Klein as well.

(7-8) Rejection under 35 U.S.C. §103(a) by Moran in view of Ciolli et al.

As noted above, the Examiner rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Moran (U.S. Patent No. 3,020,643) in view of Ciolli et al. (U.S. Patent Pub. No. US 6,546,119 B2).<sup>4</sup>

As explained above, amended claim 11 distinguishes over the Moran reference. Furthermore, the claimed features of the present invention are not realized even if the teachings of Ciolli are incorporated into Moran. Ciolli does not teach or suggest the claimed features of the present invention that are absent from Moran. Thus, amended claim 11 distinguishes over the Moran and Ciolli references, and thus claim 12 (which depends from claim 11) also distinguishes over the Moran and Ciolli references.

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<sup>4</sup> Applicant makes no statement as to whether such a combination is even proper.



Therefore, it is respectfully submitted that the rejection of claim 12 under 35 U.S.C. § 103(a) should be withdrawn.

### **CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

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